

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Comments About Amendment

At the outset, Applicants wish to address the showing required under 37 CFR § 1.116(a) regarding why the amendments above are necessary and were not presented earlier. Claims 16-30 correspond to old claims 1-15 which were pending as of the applicants' previous response dated 14 September 2001.

The presentation of the new claims is deemed necessary to eliminate any potential confusion between the actions of the preliminary amendment and the amendment of 14 September 2001. In addition, the claims have been rearranged so that like dependent claims have been grouped together (e.g. see claims 23-25 as a representative example of the rearrangement). It is believed that the newer claim simplifies the issues and eases the readability of the claims for all parties should an Appeal Brief be necessary.

35 U.S.C. 103(a) rejection

Claims 1-15 (which correspond to new claims 16-30) were rejected by the examiner as being obvious over Msika et al. (U.S. Patent 5,939,054) in view of Nakane et al. (U.S. Patent 5,182,103).

Before addressing the examiner's comments, the applicants' would like to point out an additional difference between the Msika et al. reference and the applicants' invention, i.e. the amount of emulsifier present. The applicants' preparation states that an emulsifier can be present in amounts of at most 0.5% by weight based on the total weight of the preparation (claim 17 states that the preparation can be emulsifier-free).

In contrast, Msika et al., when stating that "It will be possible to produce an emulsion of the water-in-oil type." teaches that there is an emulsifying system of between 4 and 35% by weight

not true!
added
added
sub.
months

ref. taken as
whole for ALL
teaches!

with respect to the total weight of the emulsion. One of ordinary skill in the art would not be directed toward the smaller amount of emulsifier used by the applicants and further still would not be directed toward producing emulsifier-free preparations.

The applicants' maintain their position from the previous response and add the following comments with respect to the examiner's office action.

The examiner acknowledged that Msika et al. did not represent a teaching under 102(b). As such, the Msika et al. reference is being relied upon for their broad teachings and not on any specific teaching by Msika et al. It is noted that MPEP 2111.03 also includes a section which states "Comprising is a term of art used in claim language *which means that the named elements are essential*, but other elements may be added and still form a construct within the scope of the claim." The comparison below compares what are considered the essential elements of the applicants' invention vs. that of Msika et al.

Comparison of Essential Elements

Applicants' Claimed Invention

oil phase which comprises from 10-70% by weight, based on the weight of the oil phase, of fatty and/or wax components which melt above a temperature of 40°C

a water phase

at least one modified phyllosilicate pigment particles which exhibit both hydrophilic and lipophilic properties, which thus has amphiphilic character and positions itself at the water/oil interface

at most 0.5% by weight, based on the total weight of the preparations, of one or more emulsifiers

Msika et al.

a first component selected from the group consisting of titanium oxide particles, zinc oxide particles and mixtures thereof

a second component selected from the group consisting of paste-forming oils, esters, fatty

alcohols, ethers, and mixtures thereof

a synergistic mixture between the first component and second component

a wetting point for the first component of less than approximately 5

a flow point for the first component of less than approximately 30

As can be seen from the above comparison, none of the essential elements of the applicants' invention corresponds to an essential element of Msika et al., i.e. any difference in the essential elements comes from the broad disclosures of Msika et al. or that of the secondary reference (Nakane et al.). As such, Msika et al. and Nakane et al. do not render the applicants' claimed invention obvious especially in light of the fact that neither Msika et al. nor Nakane et al. does not teach the smaller amount of emulsifier used by the applicants.

Closing

In view of the foregoing, Applicants respectfully request that the Examiner enter and consider the amendments above.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the foregoing Amendment Under 37 CFR § 1.116 (After final response) is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents, Washington, D.C. 20231, on the date indicated below:

Date: **4 February 2002**

By Howard C. Lee
Howard C. Lee